



Response Under 37 C.F.R. § 1.116  
Group Art Unit 3622, Expedited Procedure

03630.000290.

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
DONALD P. GIBSON, et al. ) : Examiner: James W. Myhre  
Application No.: 09/781,033 ) : Group Art Unit: 3622  
Filed: February 9, 2001 ) :  
For: DIGITAL IMAGE SERVICE AND ) :  
REVENUE GENERATION : August 17, 2005

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE TO FINAL REJECTION  
AND  
SUBMISSION OF DECLARATION UNDER 37 C.F.R. § 1.131

Sir:

This is a response to the final Office Action dated April 20, 2005, for which the period for response has been extended by one month, up to and including August 20, 2005.

Claims 47 to 54 are in the application, of which Claims 47 and 52 are still the only independent claims. Reconsideration and further examination are respectfully requested.

Claims 47 to 54 were rejected under 35 U.S.C. § 102(e) over U.S. Patent 6,760,128 (Jackson). The rejection is respectfully traversed.

Traversal is on the ground that Jackson does not disclose each and every element of the rejected claims, with the identity required for entry of a rejection under § 102. In particular, Jackson is not seen to disclose or to suggest at least the claimed feature of a display, in the service menu on the display of a computer, of all three of an image based on digital image data, an advertisement based on advertising information, and one or more services for printing the image data.

In maintaining the rejection over Jackson, page 5 of the Office Action argued that Jackson discloses the display of thumbnails of received digital images, the display of albums and other photo products that a user might purchase, and the display of options for printing a group of digital images into album pages. While it may be true that Jackson discloses separate displays of these items, each item is displayed individually and not in the context of a service menu. Thus, Applicants respectfully dispute the conclusion drawn by the Office Action, that Jackson somehow discloses a service menu displayed on a computer with the service menu including all three of an image based on digital image data, an advertisement based on advertising information, and one or more services for printing the image data.

Moreover, Applicants respectfully assert that Jackson is not prior art to their invention, inasmuch as the invention was conceived before the December 6, 2000 effective date of Jackson, and that from a time just before December 6, 2000 until constructive reduction to practice by filing of the application on February 9, 2001, the Applicants were diligent in their constructive reduction to practice in the United States of the claimed subject matter. In support of this assertion, this Response is accompanied by a Declaration

Under 37 C.F.R. § 1.131 To Antedate U.S. Patent No. 6,7609,128. The Declaration is made by all of the inventors herein. Since the inventors are dispersed geographically, the Declaration was prepared for each of them in individual identical copies, and each one of them executed a separate copy as noted in paragraph 4 of the Declaration. To streamline processing of this application and to reduce the size of papers filed herein (and particularly to omit needless duplication of identical copies of the exhibits), the undersigned appended all of their individual signatures onto a single copy of the Declaration, and confirms that the procedure otherwise mentioned at paragraph 4 of the Declaration was followed rigorously.

In view of the foregoing, it is respectfully submitted that the claims herein define subject matter that is not anticipated by the Jackson patent, which in any event is not prior art to the subject application, and withdrawal of the rejection over Jackson is respectfully requested.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office by telephone at (714) 540-8700. All correspondence should be directed to our address given below.

Respectfully submitted,

  
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